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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/845,315	05/01/2001	Hirofumi Wada	33216M073	2240

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SMITH, GAMBRELL & RUSSELL, LLP  
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EXAMINER

TRAN, THAI Q

ART UNIT	PAPER NUMBER
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2616

DATE MAILED: 12/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/845,315

Applicant(s)

WADA, HIROFUMI

Examiner

Thai Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed Sept. 14, 2005 have been fully considered but they are not persuasive.

In re pages 9-10, applicant argues, with respect to claim 1, that Okada fails to teach or fairly suggest each and every feature of claims 1, 2, and 10 because, in the present invention, the "plurality of recording device" are equivalent to each other in their function, each can record data from outside applicant's system and the "recording objective determination means" directly determines which specific recording device, among the plurality of (equivalent) recording devices, is to record data received from an outside source such as a broadcast station while, in Okada's system, the secondary storage unit is not equivalent to the primary storage unit and the view/playback history unit regulates the activity of the secondary storage unit and, as such, is not equivalent to the recording objective determination means of the present invention.

In response, the examiner respectfully disagrees. It is noted that claim 1 does not specifically recites "'plurality of recording device" are equivalent to each other in their function and "recording objective determination means" directly determines which specific recording device, among the plurality of (equivalent) recording devices, is to record data received from an outside source such as a broadcast station. The specification is not the measure of invention. Therefore, limitations contained therein can not be read into the claims for the purpose of avoiding the prior art. In re Sporck, 55 CCPA 743, 386 F.2d 924, 155 USPQ 687 (1968). The primary storage unit 2 and

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secondary storage unit 3 are equivalent to each other in their functions such as recording and playing back the recorded material. Claims in an application are to be given their broadest reasonable interpretation consistent with the specification, and that claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983). Moreover, limitations are not to be read into the claims from the specification. In re Van Geuns, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993), citing In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). There is nothing in the language of claim 1 which requires "recording objective determination means" directly determines which specific recording device, among the plurality of (equivalent) recording devices, is to record data received from an outside source such as a broadcast station. When claim 1 is given its broadest reasonable interpretation consistent with the specification, the view/playback history unit 16 of Okada anticipates the claimed "recording objective determination means".

In re page 11, applicant additionally argues that in Yumine's device, the user selects a recording device via switcher 20 while applicant's claimed recording objective determination means, automatically decides the recording device, without the user's instruction.

In response, the examiner respectfully disagrees. applicant cannot show non-obviousness by attacking the references individually where, as here, the rejection is based on a combination of references. In re Keller, 642 F.2d 413, 208 USPQ 871

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(CCPA 1981). The capability of automatically decides the recording device, without the user's instruction is disclosed in Okada's page 5, paragraph #005.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1 and 2 are rejected under 35 U.S.C. 102(e) as being anticipated by Okada (US 2001/0028785 A1) as set forth in the last Office Action.

Regarding claim 1, Okada discloses a data recording system (Figs. 1-2), comprising:

a plurality of recording devices (primary storage unit 2 and secondary storage unit 3 of Fig. 1, page 2, paragraph #0042) for recording data containing images and/or voice in a prescribed recording medium; and

a recording objective determination device (the control unit 5 of Fig. 2, page 2, paragraph #0049 and page 5, paragraphs #0098 and #0099) comprising at least a recording objective determination means (view/playback history unit 16 of Fig. 2, page 2, paragraph #0049 and page 5, paragraphs #0098 and #0099) of determining by a predetermined method, a recording device for recording the data among said plurality of recording devices, wherein

said recording objective determination means automatically decides which recording device should record among said plurality of recording devices by said predetermined method (page 5, paragraph #0105).

Regarding claim 2, Okada discloses a recording objective determination device (Figs. 1-2), comprising at least:

recording objective determination means (view/playback history unit 16 of Fig. 2, page 2, paragraph #0049 and page 5, paragraphs #0098 and #0099) of determining by a predetermined method, a recording device (primary storage unit 2 and secondary storage unit 3 of Fig. 1, page 2, paragraph #0042) for recording data among a plurality of recording devices each of which records data containing images and/or voice in a recording medium,

wherein when the data is recorded, the data is recorded in said recording medium of said recording device determined by said recording objective determination means, and

said recording objective determination means automatically decides which recording device should record among said plurality of recording devices by said predetermined method (page 5, paragraph #0105).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Okada (US 2001/0028785 A1).

Okada discloses all the claimed limitations as discussed in claim 2 above except for providing a computer readable medium having a program.

The capability of using microprocessor having ROM storing program to control video recorder is old and well known in the art and; therefore, Official Notice is taken.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the well known microprocessor having ROM into Okada's system in order to simplify or accurately record and play back the video programs to and from the recording medium.

6. Claims 3-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okada (US 2001/0028785 A1) in view of Yumine et al (US 5,528,746) as set forth in the last Office Action.

Regarding claim 3, Okada discloses all the claimed limitations as discussed in claim 2 above except for providing that said predetermined method is to select any of said plurality of recording device predetermined by a user.

Yumine et al teaches a cassette auto changer having plurality of recording devices (VTRs 16A to 16D disclosed in col. 4, lines 39-46) and plurality of recording media (cassette accommodating unit 13 disclosed in col. 4, lines 56-64) and the changer is selected any of the plurality of recording device predetermined by a user (external control device 12 disclosed in col. 6, lines 12-41).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the cassette auto changer as taught by Yumine et al into Okada's system in order to increase the storage capacity of the system and to complete the recording of program last for many hours.

Regarding claim 4, Yumine et al teaches at least one of said plurality of recording devices is a recording device using a removable recording medium of recording the data in a removable recording medium mounted in the device (VTRs 16A to 16D disclosed in col. 4, lines 39-46 and cassette accommodating unit 13 disclosed in col. 4, lines 56-64) and said recording device selected in advance by the user in said recording device using a removable recording medium (external control device 12 disclosed in col. 6, lines 12-41).

Regarding claim 5, Yumine et al discloses the claimed a mode is provided in which said user can optionally select a recording device for recording the data (external control device 12 disclosed in col. 6, lines 12-41) and Okada teaches the claimed said recording objective determination device further comprising selection receipt means of accepting a selection of the user as to which mode is to be selected (two modes disclosed in page 5, paragraph #0098 of Okada). When Okada and Yumine et al are combined as proposed by the examiner, the recording objective determination device of Okada would selected two mode 1) a mode in which said recording objective determination means selects a recording device (view/playback history unit 16 of Fig. 2, page 2, paragraph #0049 and page 5, paragraphs #0098 and #0099 of Okada) and 2) a



mode in which the user optionally selects a recording device (external control device 12 disclosed in col. 6, lines 12-41 of Yumine et al).

Regarding claim 6, Okada also discloses the claimed use frequency check means of checking a use frequency of each of said plurality of recording devices in the past (the automatic predicting process disclosed in page 5, paragraph #0099), wherein when said selection receipt means accepts the user selection of the mode in which said recording objective determination means determines a recording device, said recording objective determination means selects a recording device having a highest use frequency checked by said use frequency check means as a predetermined method (the automatic predicting process disclosed in page 5, paragraph #0099).

Regarding claim 7, Yumine et al also discloses the claimed wherein at least one of said plurality of recording devices is a recording device using a removable recording medium of recording the data in a removable recording medium mounted on the device (VTRs 16A to 16D disclosed in col. 4, lines 39-46 and cassette accommodating unit 13 disclosed in col. 4, lines 56-64) and said predetermined method refers to a method of selecting said recording device using a removable recording medium when said removable recording medium is mounted on said recording device using a removable recording medium (external control device 12 disclosed in col. 6, lines 12-41).

Regarding claim 8, Yumine et al further discloses the claimed wherein when a remaining recording capacity of said recording medium in said recording device for recording objective determined by said recording objective determination means is equal to or smaller than a predetermined capacity, or when it is prohibited that data is

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newly recorded in said recording medium, said recording medium of said selected recording device for recording data does not record the data (the capability of stopping recording when the tape run out disclosed in col. 9, lines 4-21).

7. Claims 9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okada (US 2001/0028785 A1) in view of Lee (US 6,839,499 B1) as set forth in the last Office Action.

Regarding claim 9, Okada discloses all the claimed limitations as discussed in claim 2 above except for providing wherein at least one of said plurality of recording devices is a recording device using a removable recording medium of recording the data in a removable recording medium mounted on the device, and at least another recording device of said plurality of recording devices is a recording device using a fixed type recording medium recording the data in a fixed type recording medium; and

said recording objective determination device further comprising control means of controlling the data such that when said recording device for recording data, determined by said recording objective determination means is said recording device using a removable recording medium, and (1) no recording medium is mounted on said recording device using a removable recording medium, or (2) a remaining recording capacity of the mounted removable recording medium is equal to or smaller than a predetermined capacity, or (3) it is prohibited that data is newly recorded in said mounted removable recording medium,

the data can be recorded in the fixed type recording medium of said recording device using a fixed type recording medium.

Lee teaches an apparatus for preserving monitored video signals having at least one of said plurality of recording devices being a recording device using a removable recording medium (recording unit 400 of Fig. 1, col. 3, lines 25-26) of recording the data in a removable recording medium mounted on the device, and at least another recording device of said plurality of recording devices is a recording device using a fixed type recording medium recording the data in a fixed type recording medium (field memory 202 of Fig. 1, col. 3, line 21); and

said recording objective determination device further comprising control means of controlling the data such that when said recording device for recording data, determined by said recording objective determination means is said recording device using a removable recording medium, and (1) no recording medium is mounted on said recording device using a removable recording medium, or (2) a remaining recording capacity of the mounted removable recording medium is equal to or smaller than a predetermined capacity, or (3) it is prohibited that data is newly recorded in said mounted removable recording medium (col. 4, lines 18-27), the data can be recorded in the fixed type recording medium of said recording device using a fixed type recording medium (col. 4, lines 28-32) so that to preserve video signals of a video recording/reproducing apparatus before a recording medium loaded in the video recording/reproducing apparatus is stolen or destroyed, and to record the preserved video signals when a new recording medium is loaded thereafter.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the capability of preserving the video signals as taught by Lee

into Okada's system in order to preserve video signals of a video recording/reproducing apparatus before a recording medium loaded in the video recording/reproducing apparatus is stolen or destroyed, and to record the preserved video signals when a new recording medium is loaded thereafter.

Regarding claim 11, Lee discloses the claimed wherein (1) after the removable recording medium is mounted on said recording device using a removable recording medium, or (2) after the removable recording medium having a predetermined amount of remaining recording capacity is mounted on said recording device using a removable recording medium, or (3) after the removable recording medium permitted to record new data is mounted on said recording device using a removable recording medium, the data recorded in the fixed type recording medium can be recorded in the removable recording medium (col. 4, lines 28-32).

8. Claims 9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okada (US 2001/0028785 A1) in view of Yumine et al (US 5,528,746) as applied to claims 3-6 above, and further in view of Lee (US 6,839,499 B1).

Regarding claim 9, the combination of Okada and Yumine et al discloses all the claimed limitations as discussed in claims 3-6 above except for providing wherein at least one of said plurality of recording devices is a recording device using a removable recording medium of recording the data in a removable recording medium mounted on the device, and at least another recording device of said plurality of recording devices is a recording device using a fixed type recording medium recording the data in a fixed type recording medium; and

said recording objective determination device further comprising control means of controlling the data such that when said recording device for recording data, determined by said recording objective determination means is said recording device using a removable recording medium, and (1) no recording medium is mounted on said recording device using a removable recording medium, or (2) a remaining recording capacity of the mounted removable recording medium is equal to or smaller than a predetermined capacity, or (3) it is prohibited that data is newly recorded in said mounted removable recording medium,

the data can be recorded in the fixed type recording medium of said recording device using a fixed type recording medium.

Lee teaches an apparatus for preserving monitored video signals having at least one of said plurality of recording devices being a recording device using a removable recording medium (recording unit 400 of Fig. 1, col. 3, lines 25-26) of recording the data in a removable recording medium mounted on the device, and at least another recording device of said plurality of recording devices is a recording device using a fixed type recording medium recording the data in a fixed type recording medium (field memory 202 of Fig. 1, col. 3, line 21); and said recording objective determination device further comprising control means of controlling the data such that when said recording device for recording data, determined by said recording objective determination means is said recording device using a removable recording medium, and (1) no recording medium is mounted on said recording device using a removable recording medium, or (2) a remaining recording capacity of the mounted removable recording medium is

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equal to or smaller than a predetermined capacity, or (3) it is prohibited that data is newly recorded in said mounted removable recording medium (col. 4, lines 18-27), the data can be recorded in the fixed type recording medium of said recording device using a fixed type recording medium (col. 4, lines 28-32) so that to preserve video signals of a video recording/reproducing apparatus before a recording medium loaded in the video recording/reproducing apparatus is stolen or destroyed, and to record the preserved video signals when a new recording medium is loaded thereafter.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the capability of preserving the video signals as taught by Lee into Okada's system in order to preserve video signals of a video recording/reproducing apparatus before a recording medium loaded in the video recording/reproducing apparatus is stolen or destroyed, and to record the preserved video signals when a new recording medium is loaded thereafter.

Regarding claim 11, Lee discloses the claimed wherein (1) after the removable recording medium is mounted on said recording device using a removable recording medium, or (2) after the removable recording medium having a predetermined amount of remaining recording capacity is mounted on said recording device using a removable recording medium, or (3) after the removable recording medium permitted to record new data is mounted on said recording device using a removable recording medium, the data recorded in the fixed type recording medium can be recorded in the removable recording medium (col. 4, lines 28-32).

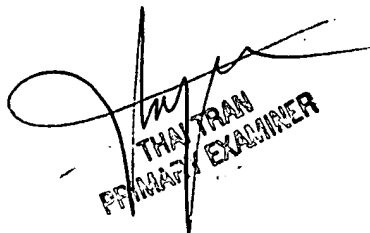
9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thai Tran whose telephone number is (571) 272-7382. The examiner can normally be reached on Mon. to Friday, 8:00 AM to 5:30 PM.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
THAI TRAN  
PATENT EXAMINER